



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/716,397

11/20/2003

Katsuaki Akama

1086.1187

5532

21171 7590 05/16/2008
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

GYORFI, THOMAS A

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

05/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/716,397	Applicant(s) AKAMA, KATSUAKI	
	Examiner Thomas Gyorfi	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/5/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 remain for examination. The correspondence filed 1/24/08 amended claims 1-14.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/24/08 has been entered.

Information Disclosure Statement

3. A corrected form PTO-1449, including an acknowledgement that item AK (the Uchida NPL reference) from the IDS filed 4/5/04 has been considered, is enclosed herein. Examiner apologizes for the prior omission.

Response to Arguments

4. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teitelbaum (U.S. Patent 5,872,834) in view of "The Frequent Traveler: How to keep your phone working when in Europe" (hereinafter, "McGinnis").

Regarding claims 1, 7, and 11:

Teitelbaum discloses a method, program, and apparatus for registering the position of a terminal equipment, comprising: registering personal information for each user, the personal information linking a subscribed terminal number, a terminal subscriber identification number and user charging information to biological information of a user possessing the terminal equipment (col. 8, lines 64-67); receiving from the terminal equipment an authentication request containing the user biological information and the terminal subscriber authentication information (col. 7, lines 30-50); retrieving personal information having biological information matching the received biological information and of changing terminal subscriber information in the retrieved personal identification into the received terminal subscriber identification information (Ibid, and col. 8, lines 10-35); transferring the subscribed terminal number in the retrieved personal information and the received terminal subscriber identification information to an exchange and of requesting position information registration which enables call in and call out as a terminal equipment having the subscribed terminal number (Ibid; and col. 8, lines 50-57).

Although Teitelbaum discloses embodiments of that invention that are practicable on cellular [wireless] phones (e.g., col. 8, line 64 – col. 9, line 10; col. 12, lines 20-30; Figure 12), there appears

Art Unit: 2135

to be no explicit teaching wherein the cell phone embodiment could be employed in the hotel embodiment cited in the claims. Nevertheless, McGinnis discloses wherein it was desirable for hotels to rent out mobile phones to their guests, prior to the instant invention (page 2, "Third-party rentals"). The claims are thus obvious because the substitution of a wireless phone as a known equivalent for the wired phone (again noting that Teitelbaum was already aware of his invention being implemented as a wireless phone) as the specific type of phone being rented by the hotel would have yielded predictable results to one of ordinary skill in the art at the time of the instant invention.

Regarding claims 2, 8, and 12:

Teitelbaum further discloses notifying a terminal equipment which has been used so far of renouncement of its use when the position information is requested of the exchange which enables call in and call out as a terminal equipment having the subscribed terminal number based on the authentication of biological information from a new terminal equipment by the received authentication request, retrieved personal information, and the transferred subscribed terminal number (col. 8, lines 5-11 and also lines 20-35).

Regarding claims 3, 9, and 13:

Teitelbaum further discloses wherein the biological information received by the received authentication request is biological information read in real time into the terminal equipment (e.g. col. 8, lines 40-50).

Regarding claims 4, 10, and 14:

Teitelbaum further discloses wherein the personal identification management step includes registering charged user identification information of a specific person among group members as

Art Unit: 2135

common charged user identification of a plurality of terminal equipments owned by group members such that the specific person is charged (col. 8, lines 10-35).

Regarding claim 5:

Teitelbaum further discloses wherein the terminal equipment is a cellular phone (Figure 12, and col. 8, line 64 – col. 9, line 10).

Regarding claim 6:

Teitelbaum further discloses wherein the biological information is a fingerprint, venous vascular network, palm print, palm shape, facial image, ear shape, or iris (e.g. col. 4, lines 20-30).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent 5,784,442 to Foti (particularly col. 1, lines 40-50)
- U.S. Patent 5,631,947 to Wittstein et al. (particularly col. 2, lines 50-65)
- U.S. Patent 5,297,189 to Chabernaude (particularly col. 1, lines 20-35).
- “A Brief Overview of GSM” by John Scourias, which teaches that the position registration limitations of the claims (see the amendment of 1/24/08, pages 7-8) were inherent to the European cell phones disclosed by McGinnis (pages 12-13, “5.2 Location updating and call routing”; cf. McGinnis, page 1)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Gyorfí whose telephone number is (571)272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

Art Unit: 2135

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG

5/12/08

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135